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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/988,069	11/16/2001	Michael A. Goldstein	37844.011900	7547

22191 7590 09/09/2003

GREENBERG-TRAURIG  
1750 TYSONS BOULEVARD, 12TH FLOOR  
MCLEAN, VA 22102

EXAMINER
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HA, TAM M

ART UNIT	PAPER NUMBER
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2175

DATE MAILED: 09/09/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/988,069

Applicant(s)

GOLDSTEIN ET AL.

Examiner

Tam M Ha

Art Unit

2175

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

SAM RIMELL

PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Oath/Declaration*

1. The declaration filed 3/6/2002 is objected to because the listed application number (60/248,840 appears to be a provisional patent application) is listed under the domestic priority claim section and claims the benefit under 35 USC 120.

If application # (60/248,840) is a provisional application, it needs to be acknowledged in the declaration under domestic priority claim under 35 USC 119 (e).

Correction or clarification is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,4,5, and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Killcommons et al (U.S. Patent No. 6,424,996).

As to claim 1, Killcommons et al teaches a system for providing remote access to documents over a computer network comprising (see column 7, lines 52-55, where "documents" is read on "medical data"):

a client computer (see column 11, lines 4-7);

scan software running on the client computer providing an interface to an input device (see column 15, lines 6-16, where “client computer” is read on “user unit”, “input device” is read on “scanner or digital camera”; it is inherent that scan software is needed for the scanner to work);

a web browser operating within the client computer (see column 15, lines 6-8);

an upload engine under the control of the browser for receiving a document from an input device (see column 11, lines 30-31; see column 12, lines 13-15, where ‘upload engine’ is read on “browser enhancement module”);

an annotations engine (see column 6, lines 22-26, where “annotation engine” is read on “annotation tools”) under the control of the browser for accessing the document received by the upload engine (see column 17, lines 16-24, where “document” is read on “patient folder” and “upload engine” is read on “browser enhancement module”);

a web server for remote storage of the received document (see column 7, lines 52-55, where “received document” is read on “medical data”).

As to claim 2, Killcommons et al teaches wherein the input device is a document scanner, digital camera or other TWAIN compatible device (see column 15, lines 6-16; see column 7, lines 23-24).

As to claim 4, Killcommons et al teaches a method providing remote access to document over a computer network (see column 7, lines 52-55, where “documents” is read on “collection of digital media”) comprising the steps of:

providing a client computer (see column 11, lines 4-8);  
running scan software on the client computer thereby providing an interface to input devices (see column 15, lines 6-16; where “client computer” is read on “user unit”; “input device” is read on “scanner”; it is inherent that scan software is needed for the scanner to work); operating a web browser within the client computer (see column 11, lines 29-31);

receiving a document as input (see column 15, lines 6-16, where “document” is read on “data”) to an upload engine under the control of the browser (see column 12, lines 12-14 and see column 11, lines 29-30, where “document” is read on “data” and “upload engine” is read on “browser enhancement software”);

accessing the document via an annotations engine under control of the browser (see column 6, lines 22-31, where “accessing” is read on “review”, “document” is read on “information”, and “annotation engine” is read on “annotation tools”); and storing the received document in a web server (see column 17, lines 20-22, where “document” is read on “patient folder”; see column 18, lines 48-50).

As to claim 5, Killcommon et al teaches wherein the input device is received from a TWAIN compatible device (see column 7, lines 23-24).

As to claim 7, Killcommon et al teaches a computer readable medium encoded with a set of executable instructions (see column 20, lines 52 and 61) to perform a method for web browser based document scanning (see column 15, lines 6-16), remote storage (see column 12, lines 12-14) and retrieval (see column 5, lines 17-22), the method comprising:

Art Unit: 2175

interfacing with input devices;

operating a web browser within a client computer;

receiving a document from an input device (see column 15, lines 6-16, where “input devices” are read on “scanner and digital camera”, “client” is read on “user”, and “document” is read on “data”) to an upload engine under the control of the browser (see column 12, lines 12-14 and see column 11, lines 29-30, where “document” is read on “data” and “upload engine” is read on “browser enhancement software”);

accessing the document via an annotations engine under control of the browser (see column 6, lines 22-31, where “accessing” is read on “review”, “document” is read on “information”, and “annotation engine” is read on “annotation tools”); and storing the received document in a web server (see column 17, lines 20-22, where “document” is read on “patient folder”; see column 18, lines 48-50).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Killcommons et al (U.S. Patent No. 6,424,996) in view of Wolff (U.S. Patent No. 6,044,367).

Art Unit: 2175

As to claim 3, Killcommons et al does not teach wherein document security is provided by the formation of a temporary working file using logical and physical metadata from the web server.

Wolff teaches wherein document security (see column 47, lines 12-26), where “document” is read on “file contents”) is provided by the formation of a temporary working file (see column 11, lines 25-39, where “working file” is read on “memory resources”) formed by logical and physical metadata from the web server (see column 10, lines 60-66, where “logical and physical metadata” is obtained by the metadata supplier module via logical/physical I/O operations with the disk reader module) from the web server (see column 4, lines 8-11).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to have modified Killcommons et al to include the document security is provided by the formation of a temporary working file using logical and physical metadata from the web server.

It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to have modified Killcommons et al by the teaching of Wolff because by including document security is provided by the formation of a temporary working file using logical and physical metadata from the web server, would not allow unauthorized user to read a previous user's file contents that were left as free space after, for example file deletion (see Wolff at column 47, lines 12-26).

As to claim 6, Killcommons et al does not teach wherein the security of the document is provided by the formation of a temporary working file using logical and physical metadata from the web server.

Wolff teaches wherein the security of the document (see column 47, lines 12-26, where “document” is read on “file contents”) is provided by the formation of a temporary working file (see column 11, lines 25-39, where “working file” is read on “memory resources”) using logical and physical metadata from the web server (see column 10, lines 60-66, where “logical and physical metadata” is obtained by the metadata supplier module via logical/physical I/O operations with the disk reader module) from the web server (see column 4, lines 8-11).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time of the invention was made to have modified Killcommons et al to include the security of the document is provided by the formation of a temporary working file using logical and physical metadata from the web server.

It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to have modified Killcommons et al by the teaching of Wolff because by including the security of the document is provided by the formation of a temporary working file using logical and physical metadata from the web server, would not allow unauthorized user to read a previous user’s file contents that were left as free space after, for example file deletion (see Wolff at column 47, lines 12-26).

### ***Conclusion***



Art Unit: 2175

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam M Ha whose telephone number is 703-305-5914. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 703-305-3830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

tmh  
September 4, 2003

  
**SAM RIMELL**  
PRIMARY EXAMINER